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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,226	02/22/2002	Russell D. Slifer	106.002US01	1661

7590 09/02/2005  
Russell D. Slifer  
2478 Warm Springs  
Boise, ID 83712

EXAMINER

LE, DEBBIE M

ART UNIT	PAPER NUMBER
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2167

DATE MAILED: 09/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/081,226

Applicant(s)

SLIFER, RUSSELL D.

Examiner

DEBBIE M LE

Art Unit

2177

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133): Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

Claims 1 and 7 objected to because of the following informalities:

In claim 1, line 8, the term "and a may need" is a typographical.

In claim 7, lines 7-8, the term "and a may need" is a typographical.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 is objected because a single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C 112, second paragraph. This type of claim is indefinite because it fails to positively recite the boundaries sought for protection. The metes and bounds of the claim cannot be determined because it is unclear as to which category of subject matter sought or protection.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grainger et al (USP Application No. 2002/0065677 A1) in view of Snyder (USP Application 2002/0111953 A1).

As per claim 1, Grainger discloses in a patent application manager system maintaining a database of references, a method comprising:

entering reference data in a database for a first patent application (as first case, ¶ 0008, Fig. 13C, # 1315, ¶ 0038);

copying the reference data to a database for a second patent application (as second case, ¶ 0008), where the second patent application is related to the first patent application (as the second case to be associated with the first case, or the first case and second case are related cases, fig. 13D, ¶ 0008, ¶ 0124);

wherein the docket entry indicates that references have been entered for the second patent application and a may need to be cited to a patent office (¶ 0059-0062);  
and

generating a viewable docket including the docket entry (fig. 14, ¶ 0106, ¶ 0118).

Grainger does not explicitly teach automatically creating a docket entry in a docketing database using the application manager system. However, Synder teaches automatically creating a docket entry in a docketing database using the application manager system (§ 0018, § 0039). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references to implement the step of automatically creating a docket entry because the docketing system is useful for intellectual property practitioners, such as patent attorneys, who have to keep track of several deadlines related to intellectual property cases. According to an embodiment of the present invention, the docketing system keeps track of deadlines related to one or more cases handled by one or more practitioners.

As per claim 2, Grainger teaches automatically creating an information disclosure statement including the reference data (§ 0120).

As per claims 3-4, Grainger teaches wherein the viewable docket is a hard copy, an electronic and viewable on a screen (fig. 14).

Claims 5 and 7 are rejected by the same rationale as state in independent claim 1 argument.

Claim 6 has the same limitations as claim 2; therefore, they are rejected by the same subject matter.

As per claim 8, Grainger teaches generate a viewable docket including the docket entry (fig. 14, § 0106, § 0118).

**Conclusion**

The prior art made of record, listed on form PTO-892, and not relied upon, if any, is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEBBIE M LE whose telephone number is (571) 272-4111. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN BREENE can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-173-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DEBBIE M LE  
Examiner  
Art Unit 2167

Debbie Le

Aug. 4, 2005.